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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,089	01/28/2002	Masahiko Murakami	1405.1056	9433
21171 7590 01/04/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER PLUCINSKI, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,089	<b>Applicant(s)</b> MURAKAMI ET AL.	
	<b>Examiner</b> Jamisue A. Plucinski	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20060412</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Response to Amendment filed 10/12/06
2. Claims 1-22 Pending.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. With respect to Claims 1, 6, 12, and 17: new matter “including addresses of non-purchasers” is considered new matter. The applicant has not specifically pointed out in the specification where the newly added claim limitation is supported. The specification talks about the system being capable of storing multiple addresses, however fails to specifically disclose the system storing address of non-purchasers. The applicant has also failed to make a statement that the amendments to the claim contain no new matter. The examiner requests that the applicant specifically point out where the new matter is located in the specification, i.e. where support can be found for the limitation of storing addresses of non-purchasers.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-9, 11-17, 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes et al. (2003/0208411) in view of Langhammer (US 2002/0099622).

4. With respect to Claims 1 and 12: Estes discloses the use of an address data management method (and system with means for) comprising the steps:

- a. Acquiring delivery address data from a user wishing to purchase an item (Reference numeral 604);
- b. Establishing a unique address ID which is encrypted (Token being encrypted and representative of the delivery address, See Figure 7) and notifying the user of such ID (See Reference Numeral 606);

Art Unit: 3629

- c. Managing a table between address data and address ID (Paragraph 0059, discloses a database which stores user information. The examiner considers a database to be a form of a table);
  - d. Accepting delivery request data from a vendor (Reference numerals 610, 614), where purchases has supplied the merchant with the address ID (Reference Numeral 612);
  - e. Looking up the address ID in the table and extracting deliver address (Reference Numeral 620 and Paragraph 0012);
  - f. Executing delivery processing based on the delivery address, extracted from the table (Reference Numerals 622 and 630).
5. Estes however, fails to disclose the acquiring step capable of storing a plurality of delivery addresses, including addresses of non-purchasers, establishing a unique address ID for each of the delivery addresses. Langhammer discloses the use of a merchant-shopping system, where a purchaser can have multiple addresses defined in the system and stored in a table, where each address receives its own unique ID, but is linked to the customer ID (See Paragraph 0076). Langhammer discloses the system collects both billing address and shipping addresses (Reference numerals 466 and 468, Figure 4D), therefore the examiner considers the system fully capable of collecting address of non-purchasers. This is done all the time when e-shopping, a consumer can choose to send an item as a gift, and therefore the address would be one of a non-purchaser. Furthermore, the address data being from a non-purchaser is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The establishing, managing, accepting, looking up and executing steps would be performed the same

Art Unit: 3629

regardless of what type of address it is, whether it be from a purchaser or a non-purchaser. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Estes to include the capability of collecting and storing multiple addresses for a consumer, as disclosed by Langhammer, in order to provide the merchant with information to minimize administrative burden on merchants, and to allow the consumer to not have to input addresses each time a purchase is made, to increase ease of use. (See Langhammer, Pages 2, 8 and 14)

6. With respect to Claims 2 and 13: Estes discloses the use of an elapse of a set length of time that address ID is good, after that, the ID is deleted from the table (Paragraph 0033).

7. With respect to Claims 3, 4, 15 and 15: Estes discloses that the token has the option of it only being used a certain number of times before it expires (Paragraph 0033). The examiner considers this to be fully capable of the number of times being only one. The range that “a certain amount of times” covers, would be inclusive of only one time.

8. With respect to Claims 5 and 16: Estes discloses the use of registering a user, where a token has the option of having a set number of times, or set amount of time before expiration, but fails to disclose the users can request the ID be deleted from the table. It is old and well known in the art that a user, when not wanting to pursue an order, or an inquiry, can cancel the order, cancel the require, unsubscribe, or unregister with a system. This is done on bulk e-mail lists, there is an “unsubscribe link”, or when a person wants to close out a bank account, they will close the account and the account is deleted from a table of open accounts. Therefore, it would

Art Unit: 3629

have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Estes, to allow for the user to cancel a token, or unregister with the system, therefore deleting the address data file, in order to increase security for a user who no longer wants to use or pursue the token or purchase.

9. With respect to Claims 6 and 17: Estes discloses the use of an address data management method (and system with means for) comprising the steps:

- g. Acquiring delivery address data from a user wishing to purchase an item (Registering, 502 and Paragraph 0026);
- h. Establishing a unique user account for identifying the purchaser (Estes discloses the token can be a unique number, such as the user's account number, Paragraphs 0012 and 0026);
- i. Managing a table between address data and user accounts (Paragraph 0059, the examiner considers the database, to be a form of a table);
- j. Authenticating purchaser using purchasers account (Reference numeral 616, Paragraph 0058), in response to a vendor inquiry (Paragraph 0077) and establishing an address ID and notify vendor of address ID (Estes sends the vendor the shipping label with an encrypted barcode, which the examiner considers to be the address ID, Paragraphs 0028, 0036, 0041);
- k. Accepting delivery request data generated by vendor that includes ID (Paragraph 0081); and
- l. Executing delivery processing based on the delivery address corresponding to address ID (Paragraph 0081).

Art Unit: 3629

10. Estes however, fails to disclose the acquiring step capable of storing a plurality of delivery addresses, including addresses of non-purchasers, establishing a unique address ID for each of the delivery addresses. Langhammer discloses the use of a merchant-shopping system, where a purchaser can have multiple addresses defined in the system and stored in a table, where each address receives its own unique ID, but is linked to the customer ID (See Paragraph 0076). Langhammer discloses the system collects both billing address and shipping addresses (Reference numerals 466 and 468, Figure 4D), therefore the examiner considers the system fully capable of collecting address of non-purchasers. This is done all the time when e-shopping, a consumer can choose to send an item as a gift, and therefore the address would be one of a non-purchaser. Furthermore, the address data being from a non-purchaser is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The establishing, managing, accepting, looking up and executing steps would be performed the same regardless of what type of address it is, whether it be from a purchaser or a non-purchaser. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Estes to include the capability of collecting and storing multiple addresses for a consumer, as disclosed by Langhammer, in order to provide the merchant with information to minimize administrative burden on merchants, and to allow the consumer to not have to input addresses each time a purchase is made, to increase ease of use. (See Langhammer, Pages 2, 8 and 14)



Art Unit: 3629

11. With respect to Claims 8 and 19: Estes discloses the use transferring the delivery request to user and accepting confirmation information from the user (See Paragraphs 0069, 0070 and 0081).

12. With respect to Claims 9 and 20: Estes discloses determining if the address ID is valid and determining whether to process delivery based on the determination (See Paragraph 0082).

13. With respect to Claims 11 and 23: Estes discloses the system callable of settling accounts with the vendor based on information relating to a settlement method (Payment Computer 108, Reference numerals 614 and 616, and Paragraphs 0026, 0028 and 0038).

14. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes et al. (US 2003/0208411) and Langhammer (US 2002/0099622) and further in view of Kirner (US 2002/0046040).

15. With respect to Claim 7 and 18: Estes and Langhammer discloses the use of a third party system for managing delivery addresses. Estes discloses the use of registering a user, but fails to disclose the use of awarding benefits to users, based on use points, or amount of times the ID is used. Kirner discloses a system where a user registers with the system, and gains awards based on the usage of services, based on points and usage (See Paragraph 0060). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Estes and Langhammer, to include an award system for usage, in order to encourage use of the system they are registered with. See Kinner Pages 5 and 6.

16. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes et al. (US 2003/0208441) and Langhammer (US 2002/0099622) in further view of Iannacci (US 2002/0062249).

17. With respect to Claims 10 and 22: Estes and Langhammer disclose the use of a method for managing the delivery of items, however, fails to disclose awarding the vendor each time a delivery request is received from the vendor. Iannacci discloses the use of a system for assigning benefits, which provides benefits to all related parties in a purchase transaction (Paragraph 262). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Estes and Langhammer, to include benefits to the merchant of the transaction, in order allow a merchant to lower product prices which will encourage and assist in the sale of additional items and enhances the relationship between consumers, merchants and third party systems. (See Iannacci, Pages 20 and 21)

#### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. The applicant is arguing the rejection based on the fact that Estes does not disclose storing a plurality of address, this newly added claim limitation is addressed in the rejection above.

19. The applicant is arguing that Estes is silent as to delivering items to others. However, this limitation does not appear in the claim. The claim states that acquiring a plurality of addresses, including address of non-purchasers, and the items are delivered to one of plurality of

Art Unit: 3629

addresses, but does not positively claim that the item has to be delivered to others, therefore argument is not considered persuasive and rejection stands as stated above.

20. The applicant is arguing all other rejections based on Estes not acquiring multiple shipping addresses, the rejection has been modified to cover the newly added claim limitations and have been addressed above, therefore the rejections stand as stated above.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cameron et al. (5,832,459) discloses the use of an e-shopping system where a user can store multiple shipping addresses.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

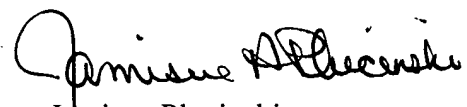
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Plucinski  
Patent Examiner  
Art Unit 3629